In the Supreme Court of the United States

OCTOBER TERM, 1946.

No. 792.

THE GENERAL METALS POWDER COMPANY,
Petitioner,

vs.

THE S. K. WELLMAN COMPANY and S. K. WELLMAN,
Respondents.

PETITION FOR REHEARING ON THE PETITION FOR CERTIORARI.

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To the Honorable the Chief Justice and the Associate Justices of the Supreme Court of the United States:

Since our Petition was filed other Court decisions have come to our attention which were rendered since the collection of decisions we cited showing the present confusion on the question of the standard or test of invention. Among these is the decision of the Eighth Circuit Court of Appeals in *Koochook v. Barrett,* 72 U. S. P. Q. 27. The Court of Appeals, in reversing the lower Court, found non-invention based upon the standard set, or held by many courts to have been set, by this Court in what is known as the "flash of genius" decision (*Cuno v. Automatic,* 314 U. S. 84).

As we pointed out in our Petition, some of the Courts had held that the standard of invention was raised by this Court in *Cuno v. Automatic* and others that it was not, and still more confusing the First Circuit Court of Appeals held that the standard of invention set in the *Cuno v. Automatic* decision had been abandoned by this Court in its decision in *Sinclair v. Carroll* and the old, or traditional, test which existed prior to *Cuno v. Automatic* had been restored.

It is apparent from reading the decision of the Eighth Circuit Court of Appeals in *Koochook v. Barrett* that the Court below had relied upon this old, or traditional, test, but that the Court of Appeals had relied upon the test of *Cuno v. Automatic* as the opinion shows (72 U. S. P. Q. 305, 31). The Court below not only cited the *Cuno* decision but quoted extensively from it on the subject. Thus we have the record of no end to this confusion among the Courts in the different circuits below on this question, and no end to the litigation and expense that is going on because of this confusion and uncertainty. We are, therefore, renewing our prayer that this Court take up the instant cause and settle this question to stay this confusion and this waste.

Specifically the question is:

Is the question of invention in patent suits to be determined on the old, or traditional, test, or to be determined on some higher standard of test and, if so, on what standard? No one, of course, has the authority or the power to stay this confusion and expense except this Court and, as we pointed out in our Petition, it is squarely presented in the instant cause where the District Judge said that he would prefer to resort to the old, or traditional, test, but did not think he had the authority to do so, which is in direct conflict with the decisions in the First Circuit where it is being applied and resorted to.

The confusion to which we refer, and the apprehension regarding it, is not limited to the Patent Bar, but extends to Research Engineers, Inventors and Judges in the lower Courts. All of this is characterized by the following quotations from an address by Judge Moscowitz of the Eastern District of New York, appearing at 5 F. R. D. 361, 375 and 376:

> "My associate, Judge Clarence G. Galston, in a well-considered address entitled 'The Imperiled Position of Our Patent System,' focused attention upon a development in Federal law, the significance of which extends far beyond the particular litigation in which it has be-

come noticeable. I refer to the trend toward invalidating patents. Our industrialization has progressed rapidly under a system which encourages competitive research and invention by affording relative assurance of compensation for successful creative effort. Those who argue that invention would continue although the reward be removed are overlooking human experience; the greater the protection afforded an inventor, the greater will be his endeavors.

* * * * *

"But many patent lawyers and research engineers have become apprehensive that the Supreme Court has pronounced an entirely new concept of invention, whereby a new device 'however useful it may be, must reveal the flash of creative genius'."

The confusion to which Judge Moscowitz refers, and to which we have referred, is illustrated by the local situation here in Cleveland, Ohio. In the Federal Court House there are two Court Rooms—one presided over by His Honor Judge Jones, and the other presided over by His Honor Judge Wilkin, who tried the cause at bar. When counsel go to the Court House to try a case there is no way of knowing whether the case will be tried by Judge Jones or Judge Wilkin.

Judge Jones follows the old, or traditional, test of invention, as indicated by the following statements by him in his opinion in the case of *Merco Nordstrom v. Acker* (Judge Jones' opinion is unpublished, but the opinion of the Court of Appeals appears at 131 Fed. (2) 277). In applying this old, or traditional, test Judge Jones said:

"In this case there has been quite a lot of time devoted to the earlier art. It is quite clear that people for countless years have been endeavoring to find means or construction for preventing leakage in flow lines and also for preventing sticking of valves, and particularly when an emergency is presented, as was described in the case out west where an earthquake occurred."

and found invention present.

In the other Court Room, presided over by Judge Wilkin, the old, or traditional, test is not followed, as we have shown at pages 17 and 18 of the Brief on our Petition for Certiorari where, though Judge Wilkin found all of these tests present, he said he regretted he could not apply them although, as we have shown, right across the Court House corridor Judge Jones is applying them.

In our Petition for Writ of Certiorari we contended, correctly, we think, that the courts are in a state of confusion in the tests of invention. Meanwhile, we honor the hundredth birthday of Thomas A. Edison and acknowledge that his discoveries and inventions have created many new industries and new jobs, and that they have solved many problems of long standing. These are important objective tests, and, are the true "surveyor's stakes" by which invention can be measured. The present confusion can result only in loss to the nation as a whole.

It is deemed unnecessary to repeat here, except to pray the Court to re-examine the points brought out by the Petition and to grant the writ.

Wherefore, it is prayed that the Petition for Writ of Certiorari in the above entitled cause be re-examined and re-considered and that the writ be granted.

Respectfully submitted,

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Feb. 24, 1947.

I hereby certify that the foregoing Petition for Rehearing is filed in good faith and not for the purpose of delay.

B. D. WATTS.